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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,921	05/23/2001	Parul A. Mittal	JP920010008US1	1619

7590 07/13/2005

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EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/863,921

Applicant(s)

MITTAL ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the paper(s) filed 3/1/05.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-6, 15-32, 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerat (US20020010627) in view of DeLapa et al (US6076068).**

Lerat teaches electronic coupons that are selected for downloading by users and that may include a parameter of value that is set to decline over time [abstract, ¶ 24]. The collection of coupon parameters (product, type of discount, amount, redemption retailer, etc) is taken to provide the structure of the promotional offer. Lerat teaches that users are identified and their history of shopping and coupon redemption is used to develop behavioral profiles [¶ 47, 80, 81]. Although Lerat teaches that coupons can be personalized for users (and hence, targeted) [¶ 74, 75], Lerat does not appear to select appropriate coupons on behalf of the user. DeLapa et al teaches an electronic coupon system where user purchases are tracked and coupons are selected on behalf of the user's profile [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have pre-selected coupons for the users and upon their logging into the system, presented (i.e. distributed the records of available targeted coupons for

Art Unit: 3622

browsing and downloading) such targeted coupons to the users of Lerat. This provides distribution of targeted offer records, acceptance of selected coupons and determination of a declining value upon acceptance by the user. The starting value is taken to provide a default value. Regarding claim 4, it would have been obvious to one of ordinary skill at the time of the invention to have reduced the value once a day (or other time period) until the offer expires; such provides a predetermined number of value changes. Regarding claim 15, the behavioral information is taken to be met by the purchasing and redemption history of the user. There is no requirement that the user redeem selected coupons and therefore the users are taken to be capable of declining redemption. Regarding claim 19, the price sensitivity of the user will determine whether the user would prefer a discounted product or a higher priced, but otherwise preferable product; this claim is not taken to positively limit the method steps taken. Regarding claim 20, the value can be virtually any amount, including the difference between a preferred brand price and the promoted products price. Further, the claims specify only a value, rather than particular steps which would determine such a value; the particular value of the offer is not taken to provide a patentable distinction. Regarding claim 21, base claim 6 does not positively require a variable offer period and therefore forth details about such a period are likewise not positively required by the claims. A customer's eligibility to redeem an offer is taken to be defined by the targeting of the offer – only certain user(s) can receive and redeem the targeted offers. Regarding claim 48, Lerat does not appear to specify or limit the type of discount value decay and

Art Unit: 3622

it would have been obvious to one of ordinary skill at the time of the invention to have provided any reasonable function including linear (x amount per day).

**4. Claims 7-14, 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerat in view of DeLapa et al and Walker et al '573 (US6327573).**

Regarding claim 7, Walker et al '573 teaches that user profiles determine different classes of users who can be given different incentive tiers [col 10, 14]. It would have been obvious to one of ordinary skill at the time of the invention to have provided different initial discount values for the coupons of Lerat based upon the user's profile/tier.

Regarding claim 8, Lerat teaches that different manufacturers can provide coupons; this provides targeted coupon offers by different entities able to access the user profiles.

Regarding claim 9, it is obvious that entities appropriately assign a discount value in order to provide an effective coupon campaign, rather than give products away at a loss.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc